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In re Application of	:	OFFICE OF PETITIONS
Rincon et al.	:	
Application No. 10/761,825	:	ON PETITION
Filed: 20 January, 2004	:	
Docket No. TI-30810A	:	

This is a decision on the petition under 37 CFR 1.53(b) filed on 14 May, 2004, requesting that the above-identified application be accorded a filing date of 20 January, 2004, with Page 3 of the specification as a part of the original disclosure.

The petition is dismissed.

On 20 January, 2004, the application was filed.

On 27 April, 2004, the Office of Initial Patent Examination (OIPE) mailed a Notice of Omitted Item(s) in a Nonprovisional Application stating that the application had been accorded a filing date of 20 January, 2004, but that Page 3 of the specification (description and claims) appeared to have been omitted from the application. A two (2) month period for reply was set.

In response, on 14 May, 2004, the present petition was filed, accompanied by Page 3 of the specification. Petitioners apparently concede that Page 3 was inadvertently omitted from the application as filed, but requests that the application, including Page 3, be accorded a filing date of 20 January, 2004, because the application is a continuation-in-part of Application No. 09/921,169 and incorporated the prior application by reference.

Petitioners' argument has been considered, but is not persuasive. The U.S. Patent and Trademark Office (Office) file is the official record of the papers originally filed in this application. A review of the papers originally filed reveals that, *inter alia*, pages 1, 2, and 4-27 of specification, including one (1) page containing the abstract, were filed on 20 January, 2004. No page 3 of the specification was filed on 20 January, 2004 no such page of specification is present among the application papers received on that date. An applicant alleging

that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. As petitioners apparently concede that the omitted page of specification was not in fact filed on 20 January, 2004, the application cannot be accorded a filing date of 20 January, 2004, with Page 3 as a part of the original disclosure.

It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.¹ This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. However, due to the absence in the record of a postcard receipt itemized with respect to the specification that bears a USPTO date stamp of 20 January, 2004, showing that 27 pages of specification, including one page of abstract, were received in the USPTO on 20 January, 2004, the application cannot be accorded a filing date of 20 January, 2004, with Page 3 as a part of the original disclosure.

Moreover, petitioners' assertion that Page 3, which was omitted on filing and a part of a copending application referenced on the application transmittal sheet, is a part of the original disclosure, is not persuasive. A review of the record reveals that the specification, as filed, consist of 25 pages of written description and claims. The specification as filed, however, does not contain Page 3. Clearly Page 3 was intended to be a part of this application. Whether Page 3 were a part of a copending application is not an issue here since the copending application was not specifically incorporated by reference into the disclosure of this application.² The mere reference to another application is not an incorporation of anything therein into the

¹ The public was afforded a "reminder" of the then extent post card receipt practice at 857 *Off. Gaz. Pat. Off.* 667 (O.G.) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the O.G. that contains important O.G. notices of continuing relevance.

² See MPEP 608.01(p). No incorporation by reference of the prior application appears on the transmittal sheet or in the specification or preliminary amendment filed on 20 January, 2004.

application containing the reference.³ To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. Page 3 was simply not filed in the USPTO on 20 January, 2004. Matter included in Page 3 may be submitted as an amendment for consideration by the examiner under MPEP sections 608.02(p) and 608.04. In view of the above, the application cannot be accorded 20 January, 2004, as the application filing date with Page 3 as a part of the original disclosure.

The application will be processed and examined using only the application papers present on 20 January, 2004. The copy of Page 3 supplied with the present petition will not be used for processing or examination, but will be retained in the application file.

Since this petition was not necessitated by an error on the part of the USPTO, the petition fee will not be refunded.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 20 January, 2004, using the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

³See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).